

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLN. NO. 09/408,264
ATTORNEY DOCKET NO. Q55802

REMARKS

Applicant thank the Examiner for acknowledging Applicants' claim to foreign priority, and for indicating that certified copies of the priority documents, European Patent Application No. 98402408.3 dated September 30, 1998 and European Patent Application No. 99401620.2 dated June 29, 1999, have been made of record in the file.

Applicant thanks the Examiner for initialing the references listed on the PTO-1449 forms submitted with the Information Disclosure Statements filed on September 29, 1999 and February 11, 2000, thereby confirming that the listed references have been considered.

Claims 1-4 have been examined on their merits, and are all the claims presently pending in the application.

1. Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Morelli *et al.* (U.S. Patent No. 6,236,674) in view of Bremer (U.S. Patent No. 6,320,879). Applicants respectfully traverse the rejection of claims 1, 3 and 4 for at least the reasons discussed below.

The initial burden of establishing that a claimed invention is *prima facie* obvious rests on the USPTO. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). To make its *prima facie* case of obviousness, the USPTO must satisfy three requirements:

1. The prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated to artisan to modify a reference or to combine references. *In re Fine*, 837

F.2d 1071, 1074 (Fed. Cir. 1988).

2. The proposed modification of the prior art must have had a reasonable expectation of success, and that determined from the vantage point of the artisan at the time the invention was made. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1209 (Fed. Cir. 1991).
3. The prior art reference or combination of references must teach or suggest all the limitations of the claims. *In re Vaeck*, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, the nature of a problem to be solved. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). Alternatively, the motivation may be implicit from the prior art as a whole, rather than expressly stated. *Id.* Regardless if the USPTO relies on an express or an implicit showing of motivation, the USPTO is obligated to provide particular findings related to its conclusion, and those findings must be clear and particular. *Id.* A broad conclusionary statement, standing alone without support, is not “evidence.” *Id.*; *see also, In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001).

In addition, a rejection cannot be predicated on the mere identification of individual components of claimed limitations. *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000). Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Id.*

The Examiner states that Morelli *et al.* disclose the interruption of a low power data packet. Applicants submit, however, that Morelli *et al.* does not disclose the active transmission of data packets in a low power mode. The passages cited by the Examiner in the October 24, 2003 Final Office Action refer to the wakeup of the transmitter in Morelli *et al.*'s device *upon receipt* of a data packet that requires a response. When the packet to be responded to is being received, the transmitter is being powered up from the sleep mode, and it is not transmitting data packets at all.¹ In addition, the Examiner has acknowledged that Morelli *et al.* fails to disclose the transmission of a copy of the interrupted data packet at full power. *See* September 24, 2003 Final Office Action, page 2.

The combination of Morelli *et al.* and Bremer fails to teach or suggest a method of transitioning a transmitter from a low bit rate/low power state to a high bit rate/high power state, as recited in claim 1. There is no teaching or suggestion in the combination of Morelli *et al.* and Bremer that a low bit rate/low power transmission of inactive data packets is interrupted when a transmitter receives active data packets for transmission. Bremer is silent with respect to low bit rate/low power transmission of inactive data packets. As discussed above, Morelli *et al.* teaches away from low bit rate/low power transmission of inactive data packets, in that transmitter of Morelli *et al.* is in "sleep mode" and is not even transmitting data packets. Furthermore, the

¹ "If it is determined that a response is necessary, the control circuit provides a control signal to the transmitter to power up the transmitter from a sleep mode even before the entire packet has been received. The control circuit then continues to process the remainder of the packet as it is received while the transmitter powers up from the sleep mode. In this manner, the transmitter will become stabilized much earlier." *See* col. 4, lines 10-17 of Morelli *et al.*; *see also*, Abstract; col. 6, lines 54-59 describing "sleep mode" of the transmitter.

Examiner appears to be confusing the “active mode” of Morelli *et al.* with the high power mode of the present invention, in that the high power mode of the present invention refers to bit rates. Morelli *et al.*’s “high power” refers to the wattage emanating from an antenna. There is no disclosure in the combination of Morelli *et al.* and Bremer of differing bit rates based on active or inactive data packets. Finally, a data packet received at the receiver, not at the transmitter, triggers the transmitter “wakeup” of the combination of Morelli *et al.* and Bremer. There is no teaching or suggestion in the combination of Morelli *et al.* and Bremer of interrupting a low bit rate/low power transmission upon receipt of active data packets at a transmitter, as recited in claim 1. Thus, Applicants believe that the Examiner cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*.

Since neither Morelli *et al.* nor Bremer disclose a method for the interruption of a low bit rate/low power transmission of inactive data packets, Applicants believe that one of skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Examiner to provide particularized facts on the record as to why one of skill would be motivated to combine the two references. Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). The Examiner must make specific factual findings with respect to the motivation to combine references. *In re Lee*, 277 F.3d 1338, 1342-44 (Fed. Cir. 2002). Although the Examiner provides a motivation analysis with respect to reliable transmission of data when switching between low and high power states,

both Morelli *et al.* and Bremer lack any teaching about the desirability of a method for the interruption of a low bit rate/low power transmission of inactive data packets. In addition, since Morelli *et al.* do not even teach the low bit rate/low power transmission of data packets, why would one of ordinary skill in the art be motivated to combine Morelli *et al.* with Bremer? Applicants believe that the Examiner cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.

Claim 3 recites an interruption means for interrupting the transmission of an idle data packet currently being transferred in a low bit rate/low power state when active data packets enter a transmitter. The Examiner acknowledges that Morelli *et al.* fails to disclose a means for retransmission of an interrupted data packet at a higher power. *See* September 24, 2003 Final Office Action, page, 3. Applicants submit that claim 3 is allowable for the same reasons as claim 1, in that the combination of Morelli *et al.* and Bremer does not teach a transmitter that interrupts a low bit rate/low power transmission of data packets upon the receipt of active data packets for transmission at a high bit rate/high power. For the sake of brevity, Applicants incorporate by reference the arguments for the patentability of claim 1 as being applicable to claim 3 as well.

Claim 4 recites a detection means for detecting an idle data packet that is being interrupted during an low bit rate/low power transmission, and a deletion means for discarding that same packet when retransmitted at a high bit rate. The Examiner acknowledges that Morelli *et al.* fails to disclose a means that detects an interrupted data packet and detection means that deletes that same interrupted packet when retransmitted at a higher power. *See* September 24, 2003 Final Office Action, page, 3. Applicants submit that claim 4 is allowable for the same

reasons as claim 1, in that the combination of Morelli *et al.* and Bremer does not teach a transmitter that interrupts a low bit rate/low power transmission of data packets upon the receipt of active data packets for transmission at a high bit rate/high power, nor does the combination teach or suggest a detection means and deletion means for handling such retransmitted packets. For the sake of brevity, Applicants incorporate by reference the arguments for the patentability of claim 1 as being applicable to claim 4 as well.

Based on the foregoing reasons, Applicants believe that the combination of Morelli *et al.* and Bremer fails to disclose all of the claimed elements as arranged in claims 1, 3 and 4. Therefore, the combination of Morelli *et al.* and Bremer clearly cannot render the present invention obvious as recited in claims 1, 3 and 4. Thus, Applicants believe that claim 1 is in condition for allowance. Applicants respectfully request that the Examiner withdraw the § 103(a) rejection of claims 1, 3 and 4.

2. Claim 2 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Morelli *et al.* in view of Bremer, and in further view of Gibson *et al.* (U.S. Patent No. 6,049,885). Applicants respectfully traverse the rejection of claim 2 for at least the reasons discussed below.

Claim 2 depends from independent claim 1. The combination of Morelli *et al.* and Bremer are deficient with respect to claim 1 for at least the reasons stated above.

Gibson is directed to an apparatus for allowing a remote node to awaken a sleeping node of a network. Gibson, however, fails to disclose the above-identified recitations with respect to independent claim 1. Therefore, Applicant submits that claim 2 is patentable at least by virtue of


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its dependency from claim 1. Applicants respectfully request that the Examiner withdraw the § 103(a) rejection of claim 2.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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